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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/826,574

04/16/2004

Lou Ann Mueller

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03/08/2007

DUANE MORRIS, LLP

IP DEPARTMENT

30 SOUTH 17TH STREET

PHILADELPHIA, PA 19103-4196

EXAMINER

TSOY, ELENA

ART UNIT

PAPER NUMBER

1762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/826,574

Applicant(s)

MUELLER ET AL.

Examiner

Elena Tsoy

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9,13 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9,13 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Amendment filed on January 10, 2007 has been entered. Claims 1-8, 10-12, and 14 have been cancelled. New claims 15-19 have been added. Claims 9, 13, and 15-19 are pending in the application.

Claim Objections

1. Objection to claim 9 because of the informalities has been withdrawn due to amendment.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Rejection of claim 9 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to amendment.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Rejection of claims 9, 13-14 under 35 U.S.C. 102(e) as being anticipated by Knauf (US 20040157025) has been withdrawn due to amendment.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9, 13, and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knauf in view of Applicants' admitted prior art.

Knauf teaches that a method of making a polymer-coated paper ream wrapper comprising applying a low density polyethylene (LDPE) layer 16 to the surface 14 of a paper substrate 12, such as Kraft paper with a basis weight of 20-80 lbs/3,000 ft² (See P23), and applying a layer of varnish 17 on top of the LDPE layer (See Fig. 3; See P17-P19). The polyethylene layer is applied in an amount of 1 lbs/3,000 ft² to 20 lbs/3,000 ft² (See P25) and is used to create a seal with the application of heat. Areas of the inner surface in proximity to a heat source during the heat sealing process and where a seal will not be beneficial (claimed specific zones) are covered with a heat shield, such as a varnish, to avoid damage to the paper. See Abstract.

Knauf fails to teach that the method includes subjecting said ream wrapper to curing apart from heating (Claims 9 and 13); the polymer layer is coated by *extruding* (Claim 17).

Applicants' admitted that during the wrapping process, the *prior* art polymer-coated paper ream wrapper made by coating, **extruding**, or otherwise covering one side of paper with a layer of low or high density polyethylene, or other polymer or poly resin, is subjected to heat or **other curing** methods, which melt the poly slightly so as to become tacky. See specification, page 2, paragraph 2.

As to claims 9, 13 and 17, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have coated a paper ream wrapper of Knauf with LDPE or other polymer or poly resin by **extruding** and subjected the coated paper to curing methods other than heat during the wrapping process since Applicants' admitted that during the wrapping process, the *prior* art polymer-coated paper ream wrapper made by coating, extruding, or otherwise covering one side of paper with a layer of low or high density polyethylene, or other polymer or poly resin, is subjected to heat or other curing methods, which melt the poly slightly so as to become tacky.

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As to claims 15-16, obviously, exact dimensions of covering with varnish would depend on particular use of a final product.

As to claim 17, Applicants' admitted that it was known to make polymer-coated paper ream wrapper by **extruding** LDPE layer or other polymer or poly resin, to one side of paper followed by subjecting the polymer-coated paper ream wrapper to heat or other curing methods.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have prepared polymer-coated paper ream wrapper by **extruding** LDPE layer or other polymer or poly resin, to one side of paper in Knauf followed by subjecting the polymer-coated paper ream wrapper to heat or other curing methods since Applicants' admitted that it was known to make polymer-coated paper ream wrapper by **extruding** LDPE layer or other polymer or poly resin, to one side of paper followed by subjecting the polymer-coated paper ream wrapper to heat or other curing methods.

8. Claims 9, 13, and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admitted prior art in view of Knauf.

Applicants' admitted that the *prior* art polymer-coated paper ream wrapper is made by coating, **extruding**, or otherwise covering one side of paper with a layer of polyethylene, low or high density polyethylene, or other polymer or poly resin. During the wrapping process, the wrapper is subjected to heat or **other curing** methods, which melt the poly slightly so as to become tacky. The tackiness of the poly enables the wrapper to seal itself in the folded end areas of the wrapper and along overlapped back panels across the girth of the wrapper. A major disadvantage of this type of wrapper is that the poly also sticks to the bottom sheet(s) of paper contained in the ream along the heat-sealed back panels. Applicants state that it was known to apply a varnish or other coating material in specific zones along the length of the inside web of said ream wrapper to prevent the heat-sealed area from sticking to the bottom sheet(s) of paper encased in the ream.

However, Knauf teaches that by applying a layer of varnish 17 on top of a *typical* paper substrate 12 such as Kraft paper with a basis weight of 20-80 lbs/3,000 ft² (See P23) that is coated with a low density polyethylene (LDPE) layer 16 (See Fig. 3; See P17-P19 in an amount of 1 lbs/3,000 ft² to 20 lbs/3,000 ft² (See P25) to create a seal with the application of heat, to areas of the inner surface in proximity to a heat source during the heat sealing process and where

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a seal will not be beneficial (claimed specific zones) allows to avoid damage to the paper. See Abstract. It is the Examiner's position that coating a paper substrate of Kraft paper with a basis weight of 20-80 lbs/3,000 ft² with a low density polyethylene (LDPE) in an amount of 1 lbs/3,000 ft² to 20 lbs/3,000 ft² in Knauf is a method *conventionally* used in the art for making polymer-coated paper ream wrapper.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied a layer of varnish on top of a polymer-paper substrate of the Applicants' admitted *prior* art to areas of the inner surface in proximity to a heat source during the heat sealing process and where a seal will not be beneficial (claimed specific zones) with the expectation of preventing damage to the paper, as taught by Knauf.

As to claims 15-17, the limitations of these claims would be obvious over cited combination of references for the reasons discussed above.

Response to Arguments

9. Applicant's arguments with respect to claims 9, 13, and 15-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ELENA TSOY
PRIMARY EXAMINER



Elena Tsoy
Primary Examiner
Art Unit 1762

March 5, 2007